



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,474	03/29/2001	Takumi Tanabe	8861-400US (P23811-01)	5649
570	7590	08/04/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			FISH, JAMIESON W	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/820,474

**Applicant(s)**

TANABE ET AL.

**Examiner**

Jamieson W. Fish

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 05-31-2005 has being considered by the examiner.

### ***Drawings***

The drawings were received on 05-31-2005. These drawings are acceptable.

### ***Response to Arguments***

Applicant's arguments filed 5-31-2005 have been fully considered but they are not persuasive. The applicant argues that the added claim language of "and also instructing how said contents should be reproduced in accordance with the way the advertising information is reproduced" renders independent claims 1, 2, 3, 7 and 9 allowable over the prior art rejections of record (See Remarks Pg 12 Paragraph 2, Pg 13 Paragraph 13). The examiner respectfully disagrees. Wu teaches where advertising scenario header also instructs how said contents should be reproduced in accordance with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51). The mapping information (advertising scenario header) comprises layout parameters. The layout parameters are instructions to the system indicating how web pages and the program schedule segment (contents) will be displayed. Overlaying an advertisement web page over the program image (PIP mode), changing how much of the area of the screen the program image occupies (changing from full-screen to split screen), and not displaying the program when the web page is displayed (toggle mode) are all ways of controlling

Art Unit: 2617

how said contents are reproduced in accordance with the way the advertising information is reproduced.

The applicant also argues that the combination of Wu and Dunn is improper (See Remarks Pg 14 Paragraph 2). The examiner respectfully disagrees. The applicant argues that Wu specifically teaches away from such a combination because Wu is specifically designed to concurrently display and not interrupt the ongoing video content as well as information from a web site (See Remarks Pg. 14 Paragraph 2). Wu teaches where mapping information indicates how advertising web pages are to be displayed in accordance with programs (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51). One of the modes for display is where the user can toggle back and forth between the display of the web page and the program (See Col. 5 lines 23-56). Such a toggling interrupts the display of the ongoing video content, since the video content is not displayed when the web page is displayed. When the web page is displayed the transmission of the program is not necessarily stopped. Since the program is transmission of the program is not necessarily stopped, the user may miss segments of the program while viewing web content. Thus, there is clear motivation to combine Wu with Dunn to stop the transmission of the program when the user toggles to the web content, so the user does not miss program segments. Although, the applicant argues that present invention is directed towards control of content without operation of the viewer, features upon which applicant relies (i.e., not operation by the viewer, the user has no control, See Remarks Pg. 14 Paragraph 3) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

Art Unit: 2617

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 2 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al (US 6,326,982).
2. Regarding claim 2, Wu teaches a broadcast system comprising a broadcast station and a television broadcast receiver connected to said broadcast station by a two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16, Dedicated Server Providing TV Programming Schedule/Web Address Mapping information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way channel. Video Data Provider (16) and Internet (22) can both be connected to Web/TV (12) through a cable network, therefore the Video Data Provider and the Server (34) are equivalent to a broadcast station), wherein said television broadcast receiver comprises a browser unit for reproducing display data coded by the Hyper Text Markup Languages (See Fig. 2 Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines 5-55. Processor and Video Processor display HTML coded data) and an Internet access unit for accessing the Internet to obtain display data coded by the Hyper Text Markup Language (See Fig. 2 Processor 56, Internet Unit 68 and Col. 4 lines 18-39 Col. 5 line 5-55. Processor and Internet Unit access Internet) and wherein said broadcast station transmits, prior to or during the transmission of contents an advertising scenario header

Art Unit: 2617

for at least instructing what kind of advertising information should be reproduced and in what way (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43, Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information is downloaded to the receiver. Information tells the receiver which web pages to access during content transmission. Web pages can include advertisement information. Therefore, programming schedule mapping information is equivalent to advertising scenario header), and also instructing how said contents should be reproduced in accordance with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and during the reception and reproduction of said contents said television broadcast receiver accesses said display data on the Internet by means of said Internet access unit and reproduces information, obtained by accessing said display data, and said advertising information by means of said browser unit in accordance with the contents of said advertising scenario header received from said broadcast station. (See Fig. 10 Step 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col. 11 lines 18-67, and Col. 12 lines 1-60).

3. Regarding claim 8, it is a method claim corresponding to the apparatus claim 2. Therefore, claim 8 is analyzed and rejected according to claim 2.

***Claim Rejections - 35 USC § 103***

4. Claims 1, 3-4, 6-7, 9-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. in view of Broadwin et al (US 5,903,816).

Art Unit: 2617

5. Regarding claim 1, Wu teaches a broadcast system comprising a broadcast station and a television broadcast receiver connected to said broadcast station by a two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16, Dedicated Server Providing TV Programming Schedule/Web Address Mapping information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way channel. Video Data Provider and Internet can both be connected to Web/TV through a cable network therefore the Video Data Provider and the Server are equivalent to a broadcast station), wherein said television broadcast receiver comprises a browser unit for reproducing display data coded by the Hyper Text Markup Language (See Fig. 2 Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines 5-55 Processor and Video Processor display HTML coded data), and a storage unit (See Fig. 2 Memory Unit 76 Col. 4 lines 40-56) and wherein said broadcast station transmits prior to or during the transmission of contents an advertising scenario header for at least instructing what kind of advertising information should be reproduced and in what way (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43, Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information is downloaded to the receiver. Information tells the receiver which web pages to access during content transmission. Web pages can include advertisement information. Therefore, programming schedule mapping information is equivalent to advertising scenario header), and also instructing how said contents should be reproduced in accordance with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and

Art Unit: 2617

during the reception and reproduction of said contents said television broadcast receiver reproduces said advertising information by means of said browser unit in accordance with the contents of said advertising scenario header received from said broadcast station (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col. 11 lines 18-67, and Col. 12 lines 1-60). Wu fails to disclose where HTML advertisement is stored in the memory and the browser unit reproduces advertisement information stored in memory. Having a television receiver store interactive programming data in memory for reproduction during the transmission of content is well known in the art as taught by Broadwin (See Fig. 8 Step 444, Abstract and Col. 11 lines 37-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wu's invention so that the receiver stored advertisement information in memory and the browser unit reproduced advertisement information from memory as taught by Broadwin so that advertisement information could be provided more quickly, thus reducing latency and providing greater responsiveness (See Broadwin Col. 3 lines 12-16).

6. Regarding claim 3, Wu teaches a broadcast system comprising a broadcast station and a television broadcast receiver connected to said broadcast station by a two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16, Dedicated Server Providing TV Programming Schedule/Web Address Mapping information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way channel. Video Data Provider and Internet can both be connected to Web/TV through a cable network therefore the Video Data Provider and the Server are equivalent to a



Art Unit: 2617

broadcast station), wherein said television broadcast receiver comprises a browser unit for reproducing display data coded by the Hyper Text Markup Language (See Fig. 2 Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines 5-55 Processor and Video Processor display HTML coded data), a storage unit (See Fig. 2 Memory Unit 76 Col. 4 lines 40-56), and an Internet access unit for accessing the Internet to obtain display data coded by the Hyper Text Markup Language (See Fig. 2 Processor 56, Internet Unit 68 and Col. 4 lines 18-39 Col. 5 line 5-15. Processor and Internet Unit access Internet) and wherein said broadcast station transmits, prior to or during the transmission of contents an advertising scenario header for at least instructing what kind of advertising information should be reproduced and in what way (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43, Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information is downloaded to the receiver. Information tells the receiver which web pages to access during content transmission. Web pages can include advertisement information. Therefore, programming schedule mapping information is equivalent to advertising scenario header), and also instructing how said contents should be reproduced in accordance with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and during the reception and reproduction of said contents said television broadcast receiver accesses said display data on the Internet by means of said Internet access unit and reproduces information, obtained by accessing said display data, and said advertising information by means of said browser unit in accordance with the contents of said

Art Unit: 2617

advertising scenario header received from said broadcast station (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col. 11 lines 18-67, and Col. 12 lines 1-60). Wu differs from the claimed invention in that his browser unit does not necessarily reproduce advertisement information stored in memory. Having a television receiver store interactive programming data in memory for reproduction during the transmission of content is well known in the art as taught by Broadwin (See Fig. 8 Step 444, Abstract and Col. 11 lines 37-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wu's invention so that the receiver stored advertisement information in memory and the browser unit reproduced advertisement information from memory as taught by Broadwin so that advertisement information could be provided more quickly, thus reducing latency and providing greater responsiveness (See Broadwin Col. 3 lines 12-16).

7. Regarding claim 4, Wu as modified by Broadwin teaches wherein said television broadcast receiver comprises an input unit for inputting data (See Wu Fig. 2 Remote Control 52 and Col. 4 lines 40-44), said advertising information includes input instruction of limiting information for reproducing a description instructing to input limiting information using said input unit (See Wu Col. 6 lines 15-43, User inputs limiting preferences via electronic fill-in form provided by server), said advertising scenario header includes information for instructing to resume the reproduction of said contents or said advertising information after data has been inputted using said input unit in response to said reproduced input instruction of limiting information (See Wu Fig. 10 Steps 270, 272, Col. 6 lines 15-43, Col. 12 lines 61-67 and Col 13 lines 1-3. The user

uses input device and browser to limit preferences via an electronic fill-in form provided by server. The mapping information includes instructions to provide user with new personalized web pages after the user completes the electronic fill-in form. This is resuming the reproduction of advertising content) and also includes information for instructing in accordance with the contents of said limiting information what kind of advertising information should be reproduced (See Wu Col. 6 lines 15-43), and said television broadcast receiver reproduces said advertising information during the reception and reproduction of said contents in accordance with the contents of said advertising scenario header and said limiting information inputted from said input unit (See Wu Col. 6 15-43).

8. Regarding claim 6, Wu as modified by Broadwin teaches wherein a data gathering unit for receiving data from said television broadcast receiver and for storing said data is provided at least either in said broadcast station or on the internet (See Wu Fig. 1 Dedicated Server 34, Fig. 3 and Col. 5 lines 63-67 and Col. 6 lines 1-14 Dedicated server is data gathering unit), said television broadcast receiver comprises a data input unit for inputting data (See Wu Fig. 2 Remote Control 52 and Col. 4 lines 40-44), and a data transmitting unit for transmitting said data to said data gathering unit (See Wu Fig. 2 Internet Unit 68 Col. 5 lines 5-23), said advertising information includes data input instruction information for reproducing a description instructing to input data using said input unit (See Wu Col. 6 lines 15-43, User inputs limiting preferences via electronic fill-in form provided by server), said advertising scenario header includes information for instructing to resume the reproduction of said contents or said

Art Unit: 2617

advertising information after said data has been inputted using said input unit in response to said reproduced data input instruction information (See Wu Fig. 10 Step 270, 272, Col. 6 lines 15-43, Col. 12 lines 61-67 and Col 13 lines 1-3. The user uses input device and browser to limit preferences via an electronic fill-in form provided by server. The mapping information includes instructions to provide user with new personalized web pages after the user completes the electronic fill-in form. This is resuming the reproduction of advertising content), and said television broadcast receiver transmits the contents of said data inputted from said input unit, to said data gathering unit by means of said data transmitting unit (See Wu Col. 6 lines 23-26 fill-in order form).

9. Regarding claims **7**, **9-10**, and **12** they are method claims corresponding to the apparatus claims **1**, **3-4**, and **6** respectively. Therefore, claims **7**, **9-10**, and **12** are analyzed and rejected according to claims **1**, **3-4**, and **6**.

10. Claims **5** and **11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. in view of Broadwin and further in view of Dunn et al. (US 5,517,257).

11. Regarding claim **5**, Wu as modified with Broadwin teaches wherein said television broadcast receiver comprises a reproduction control unit for controlling the reproduction of said contents (See Wu Col. 5 lines 44-47 Toggling between a web browser and TV viewing is controlling reproduction). Wu and Broadwin differs from the claimed invention in that the television broadcast receiver does not instruct the broadcast station through said reproduction control unit to temporarily stop the transmission of said contents when starting the reproduction of said advertising

Art Unit: 2617

information during the reception and reproduction of said contents, and instructs said broadcast station through said reproduction control unit to restart the transmission of said contents when ending the reproduction of said advertising information. However, a receiver with a control unit that can instruct a broadcast station to temporarily stop and resume the transmission a contents is well know in the art as taught by Dunn (See Col. 7 lines 63-67 and Col. 8 lines 1-31). Therefore, it would have been obvious to one of ordinary skill in the art to further modify Wu and Broadwin's reproduction control unit so that it gave the user the ability to temporarily stop the transmission of content when accessing advertisement information and the ability to resume transmission of content as taught by Dunn in order to assist the viewer in controlling the viewing of the contents transmitted from the server (See Dunn Col. 1 lines 55-56).

12. Regarding claim 11, it is a method claims corresponding to the apparatus claim 5. Therefore, claims 11 is analyzed and rejected according to claims 5.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 7/26/2005



NGOC-YEN VU  
PRIMARY EXAMINER